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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,320	11/26/2003	Latonia Matthews	59124-010201	1480

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GREENBERG TRAUIG LLP
2450 COLORADO AVENUE, SUITE 400E
SANTA MONICA, CA 90404

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,320	Applicant(s) MATTHEWS, LATONIA	
	Examiner Kurt Fernstrom	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention essentially amounts a method of relating a story. While certain methods and processes are patentable, such methods must meet the requirements of 35 USC 101. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Abstract ideas, and inventions that amount to the manipulation of abstract ideas, are not patentable subject matter. Such inventions fail to promote the "progress of science and the useful arts". See *Ex Parte Bowman*, 61 USPQ2d 1669 (unpublished). Here, the invention is directed to a method of relating a story, with the use of a "selected media". No technology appears to be implicated in the creation or use of the characters and the story. As such, the invention amounts to manipulation of abstract ideas. The step of presenting the ideas on a tangible medium such as a "selected medium" does not, by itself, bring the invention within the scope of that which advances the technological arts. See *In re Abele*, 684 F.2d 902, 214 USPQ2d 682 (1982). As a result, the claims do not contain statutory subject matter. Also, claim 18 in particular recites only the steps of "using" characters" and "rendering" the characters. It is not clear that there are any concrete steps to the method of claim 18.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite a "system" but then appear to recite method steps. As a "system" is generally an apparatus, it is not clear whether applicant is intending to claim an apparatus or a method. Also, claims 6, 9, 11 and 18 recite "other conventional tools and devices". It is not clear how the scope of the claimed invention is defined by this phrase, or how one would determine whether a tool or a device is "conventional". Also, claim 9 recites the limitation "the group of articles devices". Apart from being grammatically incorrect, this limitation lacks antecedent basis. . Also, claim 18 recites only the steps of "using" characters" and "rendering" the characters. It is not clear that there are any concrete steps to the method of claim 18, and it is not clear what "using" the characters would entail.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-8, 11 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas the Tank Engine Books ("Thomas"). Thomas discloses numerous books which involve different characters based on a group of articles. Characters in the series include Thomas the Tank Engine, Percy, Harold the Helicopter and Bertie the Bus. With respect to claim 6, various media, including books and videos, are used to relate Thomas stories. With respect to claim 7, the characters are normally inanimate objects which are personalized by adding features of a human being, including eyes, noses and mouths. With respect to claim 8, each character has a name. With respect to claims 11 and 18, the characters in the Thomas stories are vehicles, and thus relate to a common theme.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 9, 10, 12-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas. Thomas discloses all of the limitations of the claims with the exception of the characters being fastening devices selected from the recited group. This, however, is an obvious variation on the teachings of Thomas. Many other stories involving inanimate objects which are personalized into characters are known, including

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as one example the 1992 movie Beauty and the Beast. Providing characters in the form of fastening devices, rather than vehicles or other objects, does not alter the function of the method, apart from presenting different artistic choices, and thus cannot serve as the basis for patentability. To the extent that the invention helps children learn more about fastening devices, Thomas discloses that same basic concept, in that a user can learn more about vehicles.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burke, Koke, Cabrera, Barnhart, Hong, Small, Avital, Chamberlin, Gates and Balbuena disclose various devices for relating stories.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
April 7, 2004


Kurt Fernstrom